



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,353	08/19/2003	Patrick Stamm	60027.0199USU1/BS030095	3813
23552 7590 10/24/2008 MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903				
EXAMINER KARDOS, NEIL R				
ART UNIT 3623		PAPER NUMBER		
MAIL DATE 10/24/2008		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/643,353

**Applicant(s)**

STAMM ET AL.

**Examiner**

Neil R. Kardos

**Art Unit**

3623

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 and 14-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This is a **NON-FINAL** Office action on the merits in response to communications filed August 26, 2008. Claims 1, 24, and 25 have been amended. Claim 13 has been previously cancelled. Currently, claims 1-12 and 14-25 are pending and have been examined.

***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 26, 2008 has been entered.

***Response to Amendment***

3. Applicant's amendments to claims 1, 24, and 25 have been acknowledged. These amendments necessitate the new grounds of rejection, found below.

***Response to Arguments***

4. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**6. Claims 1-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims 1 and 24: Claims 1 and 24 are directed toward the statutory category of a process. In order for a claimed process to be patentable subject matter under 35 U.S.C. § 101, it must either: (1) be tied to another statutory class (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *See Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method/process is not patentable subject matter under § 101. Thus, to qualify as a statutory process under § 101, the claim should positively recite the other statutory class to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state).

Here, the claimed invention does not transform underlying subject matter to a different state or thing because it merely provides an employee scorecard. Furthermore, the claimed process is not tied to another statutory category, such as a particular apparatus. The claimed process steps are capable of being carried out by the human mind. Thus, the claimed process is not patentable under § 101.

Claim 25: Claim 25 recites a system comprising a service center, an engine, and a database. These items as recited do not necessarily constitute a physical structure, such as

computer hardware. Rather, they could be software. The claim does not recite any physical structures necessary to constitute a system. Therefore, the claimed invention does not fall within a statutory class of patentable subject matter.

Claims 2-23: Dependent claims 2-23 are rejected for failing to remedy the deficiencies of the claims from which they depend.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**8. Claims 1-12, 14-17, 19, 21, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richman (US 6,754,874) in view of Whitacre (US 2004/0138944).**

Claim 1: Richman discloses a method for aggregating and reporting customer feedback information comprising:

- conducting a survey by asking at least one survey question about at least one performance category associated with a survey subject to at least one survey participant (see generally column 3: lines 43-62; column 5: lines 43-46; column 6: lines 20-24; figures 4 and 6; see figure 1, depicting participants evaluating employees; figure 9, depicting survey questions with multiple possible responses);

- collecting responses from the at least one survey participant in response to the at least one survey question (see id. above);
- determining performance scores for the at least one performance category (see figure 4: items 430-440, depicting different scores for different core competency areas; column 7: lines 30-36; column 8: lines 14-35; column 9: lines 10-15);
- assembling feedback analysis information, wherein the feedback analysis information comprises the performance scores and performance comments for the at least one performance category from the at least one survey participant about the performance of the survey subject (see figure 4: items 450-460, depicting performance comments on a scorecard; figure 6: item 640; figure 9: item 930; column 7: lines 30-36 and 52-59; column 9: lines 10-15);
- querying a database with the feedback analysis information associated with the survey subject and the at least one performance category for a coaching comment (see “Response to Arguments” section, above; column 7: lines 61-64, disclosing importing goals from a database; column 7: lines 65-67 and column 8: lines 1-13, disclosing importing expectations and training information from a database; column 11: lines 61-67; column 12: lines 1-24; column 20: lines 30-47; column 18: lines 17-20; column 13: lines 1-10; column 11: lines 62-63; column 12: lines 40-49);
- determining the coaching comment for the at least one performance category based on the feedback analysis information for the at least one performance

category (see figure 4: items 450-460, depicting suggestions for improvement; figure 6: item 640; column 7: lines 52-64; column 8: lines 5-13; column 10: lines 16-17); and

- preparing a performance survey subject scorecard containing a performance score and coaching comment for the at least one performance category (see figures 4 and 6).

Richman does not explicitly disclose determining a performance trend for the at least one performance category based on the performance comments. Whitacre teaches this limitation (see figure 2: item 128: “Agent Trending”; figure 8, depicting performance over several periods; figure 13, depicting a trending report). Richman and Whitacre are both directed to employee evaluation. It would have been obvious to one of ordinary skill in the art at the time the invention was made to determine trending data as taught by Whitacre when creating the scorecards of Richman. One of ordinary skill in the art would have been motivated to do so for the benefit of accurate evaluations (see Whitacre: ¶¶ 3 and 29).

Whitacre also discloses determining a coaching comment based on the determined performance trend and a comparison of performance scores to those of at least one second survey subject (see sections cited above for performance trending; see ¶¶ 8, 38 and 46 for a comparison to peers; ¶ 8 regarding regular feedback and frequent reporting; see also ¶ 39). It would have been obvious to one of ordinary skill in the art at the time the invention was made to base feedback of Richman off of the variety of factors disclosed by Whitacre. One of ordinary skill in the art would have been motivated to do so for the benefit of a more accurate and thorough evaluation.

Whitacre suggests wherein determining the coaching comment comprises selecting the coaching comment from a plurality of predefined coaching comments (see ¶ 49, disclosing a variety of predetermined comments based on the performance score). Furthermore, Examiner takes Official Notice that it was well-known in the art at the time the invention was made to use recommendation/suggestion databases to make recommendations or suggestions based on input. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate such a recommendation/suggestion database in the employee evaluation system disclosed by Richman. One of ordinary skill in the art would have been motivated to do so for the benefit of efficiencies gained by automating feedback.

Claim 2: Richman discloses wherein the survey subject scorecard further contains the performance comments received from the at least one survey participant for the at least one performance category (see figure 6: items 620 and 640, depicting displaying different comments in block 640 depending on which category is selected in block 620; column 15: lines 1-3).

Claim 3: Richman discloses prior to determining performance scores for each of the one or more performance categories, categorizing responses to each of the one or more survey questions by survey subject and by one or more performance categories associated with the survey subject (see figure 4: items 430-440 and figure 6: item 620, depicting categorizing responses to different performance categories; column 16: lines 39-67 and column 17: lines 1-12, disclosing sorting responses by employee).



Claim 4: Richman discloses a method whereby determining performance scores for each of the one or more performance categories includes analyzing a set of survey responses collected from one or more survey participants responsive to questions about the performance of the survey subject (see figure 4: items 420-440, depicting responses from a feedback receiver “FR” and feedback provider “FP” at items 430-440 and overall expectations at item 420; column 10: lines 12-15, wherein the rating can be changed after considering existing ratings).

Claim 5: Richman discloses a method further comprising comparing the performance scores for each of the one or more performance categories with performance scores for the one or more performance categories from a prior survey period (see column 15: lines 3-10; column 16: lines 25-38).

Claim 6: Richman discloses a method further comprising comparing the performance scores for each of the one or more performance categories with performance scores for the one or more performance categories associated with a group of survey subjects (see column 18: lines 5-14, disclosing comparing employee scores in a peer comparison).

Claim 7: Richman discloses a method further comprising forwarding the survey subject performance scorecard to a survey subject supervisor (see figure 3: items 315-320 and 330-335; figure 4: item 480; column 6: lines 6-9; column 8: lines 54-67 and column 9: lines 1-26).

Claim 8: Richman discloses a method further comprising posting the survey subject performance scorecard to an internet-based web page (see column 6: items 6-9; column 8: lines 54-67 and column 9: lines 1-26; column 16: lines 38-48).

Claim 9: Richman discloses after collecting responses from each of the one or more survey participants in response to each of the one or more survey questions, storing the responses in a survey results database (see id. above).

Claim 10: Richman discloses a method further comprising preparing a summary report for each survey subject containing responses to each of the one or more survey questions from each of the one or more survey participants (see column 17: lines 54-67 and column 18: lines 5-15).

Claim 11: Richman discloses a method further comprising forwarding the summary report to the survey subject supervisor (see id. above; column 16: lines 38-67 and column 17: lines 1-12, disclosing allowing supervisors to access the reports; column 9: lines 38-55).

Claim 12: Richman discloses a method prior to categorizing responses to each of the one or more survey questions by survey subject and by one or more performance categories associated with a the survey subject, querying a survey results database for responses for each of the one or more survey participants in response to each of the one or more survey questions (see

column 16: lines 38-65, disclosing using a pull-down menu to view scorecards from different survey participants; column 20: lines 30-47).

Claim 14: Richman discloses prior to conducting a survey by asking one or more survey questions about one or more performance categories associated with a survey subject to each of one or more survey participants, identifying one or more survey participants (see column 3: lines 43-62).

Claim 15: Richman discloses a method whereby identifying one or more survey participants includes identifying a survey sampling group based on the survey subject about which the survey is to be conducted (see column 6: lines 1-17).

Claim 16: Richman discloses a method further comprising obtaining contact information for each of the one or more survey participants (see figure 4: item 410; figure 9: item 910).

Claim 17: Richman discloses a method further comprising conducting the survey by live interview with each of the on or more survey participants (see column 12: lines 56-67 and column 13: lines 1-67 and column 14: lines 1-54).

Claim 19: Richman discloses a method further comprising conducting the survey by Internet-based interview session with each of the on or more survey participants (see column 8: lines 54-67 and column 9: lines 1-26; column 16: lines 38-48).

Claim 21: Richman discloses a method whereby the survey subject is an employee (see column 3: lines 43-62).

Claim 23: Richman discloses a method whereby the survey subject is a service (see figure 9).

Claim 24: Claim 24 is substantially similar to claim 1 and is rejected under similar rationale.

Claim 25: Claim 25 is substantially similar to claim 1 and is rejected under similar rationale. Claim 25 is directed to a system, which both Richman (see figure 1) and Whitacre (see figure 1) disclose.

**9. Claims 18, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richman in view of Whitacre, and further in view of Nanos (US 6,381,744).**

Claim 18: Richman does not explicitly disclose a method further comprising conducting the survey by interactive voice response session with each of the on or more survey participants.

Nanos teaches recording verbal survey responses via a microphone (see column 9: lines 51-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the verbal survey response means taught by Nanos to gather the survey data in

the invention of Richman. One of ordinary skill in the art would have been motivated to do so in order to allow the user to respond to open-ended survey questions (see Nanos: column 9: lines 51-53).

Claim 20: Richman does not explicitly disclose a method further comprising conducting the survey via a survey kiosk with each of the on or more survey participants.

Nanos teaches this limitation (see title; abstract; column 5: lines 42-60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the means taught by Nanos to gather the survey data in the invention of Richman. One of ordinary skill in the art would have been motivated to do so in order to provide an automated, reprogrammable means of collecting survey data at a specific location (see Nanos: column 1: line 9 through column 4: line 46).

Claim 22: Richman does not explicitly disclose a method whereby the survey subject is a product.

Nanos teaches this limitation (see column 10: lines 1-22)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the invention of Richman to evaluate products as taught by Nanos. One of ordinary skill in the art would have been motivated to do so in order to test products (see Nanos: column 1: lines 9-15).

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Potenza (US 2002/0173934), directed to an automated survey and report system, including a recommendations database.
- Frank (US 7,367,808), directed to an employee retention system, including evaluations and scorecards.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. Kardos whose telephone number is (571) 270-3443. The examiner can normally be reached on Monday through Friday from 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neil R. Kardos  
Examiner  
Art Unit 3623

NRK  
10/21/08  
/Jonathan G. Sterrett/  
Primary Examiner, Art Unit 3623